

III. REMARKS/ARGUMENTS

A. Status of the Claims

Claims 11-35 are pending. Claims 1-10 have been cancelled, without prejudice. Claims 12, 13, 17, 18, 20-26, 32 and 34 are withdrawn from consideration. Claims 15, 16, 30 and 35 are allowed. Claims 11, 14-16, 19, 27-31, 33 and 35 stand rejected. Claims 11 and 27 have been amended. No new matter is introduced by these amendments, and these amendments are fully supported by the specification. Applicants respectfully request reconsideration of the rejections of these claims for at least the following reasons.

B. Examiner Interview

Applicants would like to thank Examiner Prone for the courtesy extended to Applicants' representative during a telephonic interview on April 18, 2008. During the interview, Applicants' representative argued that a "histologic-grade slice" was a thin slice having a thickness on the order of microns, while a bacon slice would be thicker by several orders of magnitude. While Examiner Prone appreciated this distinction, no agreements were reached. Applicants' representative agreed that he would consider amending the claims to further distinguish the histologic-grade slice from the bacon slice of the prior art.

C. Claim Rejections Under 35 U.S.C. § 102(b)

Claims 11, 14, 19, 27-29, 31 and 33 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 3,846,958 to Divan. Applicants respectfully disagree.

In order for a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the . . . claim.").

Independent claim 11 recites:

An apparatus for applying thin sections of a tissue sample to a receiving medium comprising:

a blade assembly for slicing a histologic-grade slice from a tissue sample;

a plurality of transfer rollers sequentially arranged in tangential proximity to each other, such that said histologic-grade slice in contact with a surface of one transfer roller will be transferred to the surface of the sequentially successive transfer roller;

wherein a first sequential transfer roller of said plurality of transfer rollers is oriented in proximity to said blade assembly so that said histologic-grade slice sliced from said tissue sample will contact the surface of said first sequential transfer roller; and

a receiving medium disposed in tangential proximity to a final sequential transfer roller of said plurality of transfer rollers so that said histologic-grade slice on the surface of said final sequential transfer roller will be transferred to said receiving medium in a substantially smooth and flat configuration;

wherein the histologic-grade slice has a thickness of between 1 and 10 microns.

Appl'n, Claim 11 (emphasis added). Support for this amendment may be found at least in paragraph 0011 of the published application.

In order to expedite the prosecution of this application, Applicants have amended claims 11 and 27 to specify that the histologic-grade slice has a thickness

of between 1 and 10 microns. This is an inherent property of a histologic-grade slice -- a slice that is to be viewed with, for example, a microscope. This amendment thus simply further defines this inherent property of a histologic-grade slice, it should not raise any new issues for consideration.

As Applicants have argued previously, Divan does not disclose a device for slicing histologic-grade slices. Rather, Divan discloses an apparatus for slicing bacon and for the arrangement of the bacon in a shingled form with controlled weight. Divan, Col. 1, ll. 6-8. Bacon is not sliced in micron-widths; it is sliced to have a thickness that is several orders of magnitude thicker. Therefore, Divan cannot anticipate claims 11, 14, 19, 27-29, 31 and 33, and Applicants respectfully request allowance of independent claim 11 and all claims dependent thereon.

IV. CONCLUSION

Applicants respectfully submit that the application is in condition for allowance. Applicants believe that no fees are necessary in connection with the filing of this document. In the event any fees are necessary, please charge such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,
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